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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|-------------------------------|---------------------|------------------|
| 10/014,250 | 12/10/2001 | Kiyoshi Hayashi | 10873.848US01 | 2773 |
| 7590 02/24/2004 | | | | |
| Merchant & Gould P.C. P.O. Box 2903 Minneapolis, MN 55402-0903 | | EXAMINER MAPLES, JOHN S | | |
| | | ART UNIT PAPER NUMBER 1745 | | |
| DATE MAILED: 02/24/2004 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/014,250

Applicant(s)

HAYASHI ET AL.

Examiner

John S. Maples

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1745

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 November 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4 and 5 ~~is/are~~ are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,5 ~~is/are~~ are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1, 2, 4 and 5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. (New Rejection)

In claim 1, there is no antecedent basis for the word "plate" found in line 5.

Claims 2, 4 and 5, dependent on claim 1, fall therewith.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 2, 4 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Yoshii et al.-US 5,637,416 (Yoshii) (New Rejection)

Reference is made to the Abstract of Yoshii along with column 1, lines 5-8; column 2, line 61 through column 3, line 10, Example 1, and column 5, lines 6-26. See also Figures 4 and 5 in Yoshii. In these portions of Yoshii, the nickel hydroxide positive electrode has an intermediate portion therein that has a higher porosity than outer portions thereof.

5. Claims 1, 2, 4 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Matsumoto et al.-US 4,251,603 (Matsumoto).

Reference is made to column 3, lines 58-6 of Matsumoto along with column 4, line 65 through column 5, line 35; column 6, lines 38-46 and column 7, lines 21-31. See also Figure 1 of Matsumoto where it can be clearly seen that the porosity of the top portion is lower than the

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porosity further within the electrode by virtue of there being less plaque material toward the middle of the electrode. It is also noted that in claims 2 and 5, applicant has claimed process steps, however applicant's claims are product claims. Because Matsumoto teaches the claimed product, it is irrelevant how the product is made so applicant's claims are anticipated by the patent to Matsumoto.

Applicant's arguments have all been considered but are not deemed persuasive. Applicant argues that Matsumoto does not teach varying the porosity of the electrode composition. The examiner respectfully disagrees. In both column 5, lines 27-31 and column 6, lines 38-46, Matsumoto states that the porosity of the electrode is higher within the electrode than on outer portions thereof. These portions of Matsumoto clearly show that the porosity of the electrode is varied. It is also to be noted that applicant never argued these particular portions in the patent to Matsumoto.

A further argument by applicant is that Matsumoto states that the porosity of the electrode throughout is the same. This may be true, however, two other portions of Matsumoto, namely, column 5 and column 6, state differently. As set forth in the previous paragraph, the porosity within the electrode varies and is higher on the inside than in outer portions thereof.

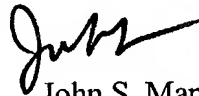
Applicant's arguments relating to the '713 reference are convincing and thus the rejection based thereon is withdrawn.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John S. Maples whose telephone number is 571-272-1287. The examiner can normally be reached on Monday-Thursday from 6:15-3:45.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Ryan can be reached on 571-272-1292. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John S. Maples
Primary Examiner
Art Unit 1745

JSM/2-19-2004